

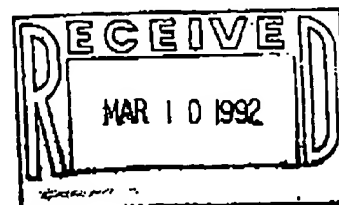


NO. 1808 P. 21  
SCR 184.1  
SCR-0819P  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

DATE: 02/05/92

TO:

THE SCRIPPS RESEARCH INSTITUTE  
OFFICE OF PATENT COUNSEL  
10666 N. TORREY PINES RD.  
MAIL DROP TPC 8  
LA JOLLA, CA 92037



UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

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ASSIGNOR:  
HIATT, ANDREW C.

DOC DATE: 10/31/91

ASSIGNOR:  
HEIN, MICH B.

DOC DATE: 10/31/91

RECORDATION DATE: 01/10/92 NUMBER OF PAGES 002 REEL/FRAME 5967/0324

DIGEST :ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE:  
SCRIPPS RESEARCH INSTITUTE, THE  
A CORPORATION OF CA

SERIAL NUMBER 7-591823 FILING DATE 10/02/90  
PATENT NUMBER 5,202,422 ISSUE DATE 00/00/00

04/13/93

APPENDIX A

ML

DEC. 9. 2004 4:47PM

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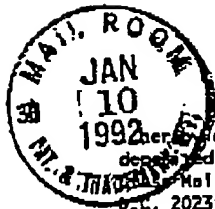
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NO. 1808 P. 22

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40-581-D

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this RECORDAL OF ASSIGNMENT and the documents referred to as enclosed therein are being deposited with the United States Postal Service on the date indicated below with sufficient postage as First Class Mail in an envelope addressed to: Box Assignment, Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date written below.

Thomas Fitting  
Thomas Fitting, Reg. No. 34,163

January 7, 1992  
Date of Deposit

Applicant: Hiatt et al.

Serial No.: 07/591,823

Filed: October 2, 1990

For: COMPOSITIONS CONTAINING  
GLYCOPEPTIDE MULTIMERS AND  
THEIR USE

)  
)  
) Group Art Unit: 186  
)  
) Examiner: R. Budens  
)  
) Our Ref. No. 581-9319P  
) San Diego, California  
) January 7, 1992

RECORDAL OF ASSIGNMENT UNDER 37 CFR §1.331

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

Kindly record the enclosed Assignment for the above-identified patent application. When the recordal has been effected, please return the original Assignment document to the undersigned.

Enclosed is Check No. 179 in the amount of \$40.00 to cover the fees associated with recordal of Assignment according to 37 CFR §1.21(h).

Please charge any additional fee concerning this matter to our Deposit Account No. 19-0962.

Respectfully submitted,

By Thomas Fitting  
Thomas Fitting, Reg. No. 34,163

THE SCRIPPS RESEARCH INSTITUTE  
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ASSIGNMENT

Serial No. 07/591,823

Filed October 2, 1990

In Consideration of One Dollar and other good and valuable considerations, the receipt of which is hereby acknowledged, the entire right, title and interest in the invention or improvements of the undersigned in COMPOSITIONS CONTAINING GLYCOPEPTIDE MULTIMERS AND THEIR USE

and in the application for Letters Patent of the United States therefor, and in any reissue or extension of any letters Patent that may be granted upon said application are hereby assigned by the undersigned to THE SCRIPPS RESEARCH INSTITUTE,  
A California Corporation

, and the heirs, successors, legal representatives and assigns of THE SCRIPPS RESEARCH INSTITUTE (herein collectively called said Assignee), and the Commissioner of Patents and Trademarks is hereby authorized and requested by the undersigned to issue said Letters Patent to said Assignee.

For said considerations it is hereby agreed by the undersigned, upon the request of said Assignee, to execute any necessary and proper oaths or affidavits relating to said application or required for the filing or prosecution of any divisional or continuing application thereof or for the filing or prosecution of any application for the reissue or extension of any Letters Patent that may be granted on said invention or improvements that said Assignee may deem necessary or expedient, and for said considerations it is further agreed by the undersigned, upon request of said Assignee, in the event of said application or any division thereof, or Letters Patent issued thereon, or any reissue or application for the reissue thereof, becomes involved in Interference, to cooperate to the best of the ability of the undersigned with said Assignee in the matters of preparing and executing the preliminary statement and giving and producing evidence in support thereof, and further to perform, on such request, any and all affirmative acts to obtain said Letters Patent and vest all rights therein hereby conveyed in said Assignee as fully and entirely as the same would have been held and enjoyed by the undersigned if this Assignment and sale had not been made. And for said considerations the entire right, title and interest in said invention or improvements, including all priority rights, and the right to claim priority rights and the privileges and benefits thereof, including those under the International Convention, and all other Conventions, and the right to file applications for patent in said Assignee's own name for said invention or improvements in each and every country of the world are hereby assigned and granted by the undersigned to said Assignee. It is further agreed by the undersigned, upon the request of said Assignee, to execute any and all documents that shall be required of the undersigned to be executed in connection with any and all applications for foreign Letters Patent therefor, including the prosecution thereof, and to execute any and all documents necessary to invest title in said foreign applications and patents in said Assignee. The attorneys of record in said application for patent are hereby authorized and requested by the undersigned to insert in this Assignment the date and serial number thereof in the places provided therefor.

RECORDED  
PATENT AND TRADEMARK  
OFFICE

JAN 10 1992

Andrew C. Hatt (Seal)

Mich B. Hein (Seal)

State of California

County of San Diego

On this 31<sup>st</sup> day of October, in the year 1991, before me, a Notary Public in and for the State and County aforesaid, personally appeared Andrew C. Hatt and Mich B. Hein

, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose names are subscribed to this instrument, and acknowledged that they executed it.

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark OfficeAddress: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, DC 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/612,406	05/03/96	HEIN	M TSRI-184.2

APRIL C. LOGAN  
THE SCRIPPS RESEARCH INSTITUTE  
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18M2/0722

EXAMINER
HAAS, T


ART UNIT	PAPER NUMBER
1803	11

DATE MAILED: 07/22/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Exhibit B**

<b>Office Action Summary</b>	Application No. <b>08/042,408</b>	Applicant(s) <b>Hein et al.</b>	
	Examiner <b>First Last</b>	Group Art Unit <b>1234</b>	

☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 7 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been

☐ received

☐ received in Application No. (Series Code/Series Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/642,406

Page 2

Art Unit:

### DETAILED ACTION

#### *Election/Restriction*

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to transgenic plants which produce secretory antibodies, classified in class 800, subclass 205, for example.
  - II. Claims 13-20, drawn to a method of passively immunizing a human or animal subject against a preselected ligand, comprising administering a biologically active immunoglobulin, classified in class 424, subclass 184.1, for example.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of invention II can be practiced with another materially different product, such as immunoglobulins produced through non-recombinant methods. The transgenic plants of invention I are not necessary for the process of invention II. Furthermore, inventions I and II each require physiological and biochemical techniques and methods not required by the other. For example, the transgenic plants of invention I require molecular cloning, plant transformation and regeneration techniques not required by invention II.

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Art Unit:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Haas whose telephone number is (703) 305-7270. The examiner can normally be reached on Mon.-Fri. from 7:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Robinson, can be reached on (703) 308-2897. The fax phone number for this Group is (703) 308-4227.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DOUGLAS W. ROBINSON  
SUPERVISORY PATENT EXAMINER  
GROUP 1800